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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78940043
Applicant	Inca Textiles, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Proceeding	78940043
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Mark	INCA MAMA
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 78/940,043

For the Mark INCA MAMA

By Appellant Inca Textiles, LLC

Filed on July 28, 2006

APPELLANT'S EX PARTE APPEAL BRIEF

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STATEMENT OF THE ISSUES

The sole issue before the Board is whether there is a likelihood of confusion between Appellant's mark, INCA MAMA, and the mark shown in U.S. Registration 2,735,016.

RECITATION OF THE FACTS

A. Procedural History

On July 28, 2006, Appellant Inca Textiles, LLC filed an application, serial number 78/940,043, requesting protection on the Principal Register in International Class 025 for “maternity wear and clothing for pregnant and nursing women, namely sweaters, wraps, coats, dresses, skirts, shirts, tops, pants, nightgowns and comfort wear” for the mark INCA MAMA.

On December 23, 2006, an Office Action issued alleging a likelihood of confusion with U.S. Registration No. 2,735,016.

On March 27, 2007, Appellant filed a Response, presenting arguments and evidence.

On May 21, 2007, a Final Office Action issued that repeated the rejection, realleging likelihood confusion and that Appellant's arguments were not persuasive.

On October 29, 2007, Appellant filed a request for reconsideration including additional evidence.

Appellant filed this ex parte appeal on October 30, 2007.

On November 20, 2007, the Request for Reconsideration was denied.

B. Evidence of Record

The file of the subject application, including the December 23, 2006 Office Action, Appellant's March 27, 2007 response, and the May 21, 2007 Final Office Action is of record. In addition, the record contains Appellant's Request for Reconsideration and the additional evidence attached and the Examining Attorney's denial. TBMP § 1207.04.

Appellant further submits an additional copy of U.S. Registration No. 2,735,016 to mark INCA GIRL plus design for International Class 025 for "clothing; namely, tee shirts, sweatshirts, shorts, pants, jeans, jackets, skirts, dresses, caps and socks and footwear; namely, shoes, sandals and boots."

ARGUMENT

Summary of Argument

The Examining Attorney made a number of errors in evaluating likelihood of confusion between the current application and Reg. No. 2,735,016 ("016 registration").

1. Ample, uncontradicted evidence of record establishes INCA as a weak and/or non-dominant term, contrary to the Examining Attorney's unsubstantiated opinion that the term is dominant.
2. In contrast to Applicant's mark, which connotes motherhood or maternity, Registrant's mark is the image of a scantily clad young woman, which conveys anything but motherhood or maternity.
3. The Examining Attorney erred in ignoring the prominent nature of the image against the tiny words of the cited registration.
4. GIRL and MAMA are incorrectly generalized as merely "female," when each connotes something very different from the other.

5. Purchasers of maternity clothing do not buy on impulse and exercise substantial care in purchases, as demonstrated by the overwhelming evidence of record.

A. The female figure dominates the tiny words “inca girl” in the cited registration.

In the case of composite marks like the '016 registration cited by the Examining Attorney, a determination of whether the design or word portion is dominant is required.

“[W]here a mark is a composite mark including a design and a word then which of the two features dominates the mark is usually controlling in the determination of likelihood of confusion.” *In re Strathmore Products, Inc.*, 171 U.S.P.Q. 766 (TTAB 1971). The Examiner has erroneously assumed without comment that the word portion the '016 registration is dominant.

While the *Strathmore Products* panel found that the “teardrop design serves as a background for wording,” the design in the '016 registration is so different that the reasons in that case cannot apply here. As shown at right, the tiny INCA GIRL words are dominated by a much larger female figure. The words occupy less than five percent of the total space and make little contribution to the overall commercial impression. Those familiar with this mark agree that the design portion is dominant.



Ms. Dori Rhoades notes in her declaration, “the most striking and dominant element of this trademark is the thin, tall girl in her scant attire.” Decl. of Dori Rhoades p4.

In addition, the overall meaning is more accurately conveyed by the design rather than the words. The mark “speaks to young, fashion-conscious girls, and it strongly conveys youthful sexiness.” *Id.* This youthful sexiness is conveyed by the youthful, slender figure as well as the figure's “scant attire” rather than the words INCA GIRL. While the words INCA GIRL are present in the mark, they are dominated by the graphical features both in size and commercial

impression.

The Examining Attorney's claim that "the word portion is more likely to be impressed upon a purchaser's memory" is correct as a general statement of probability; however, general likelihood cannot be converted to specific certainty without further analysis. Nor are word portions dominant as a matter of law. For example, *In re Computer Communications* held that the "board properly considered both marks in their entireties, and was of the view that the design portion of appellant's mark was its most visually prominent feature." 484 F.2d 1392, 1393, 179 USPQ 51 (CCPA 1973). The Examining Attorney summarily states that the "word portion in the registrant's mark is controlling" without considering both marks in their entirety or finding that the design or word portion was more visually prominent. Proper consideration of the relative weight of the design and word portion shows that the word portion plays a minor role compared to the visually dominating and connotatively distinguishing design portion.

B. The Examining Attorney exaggerates the role of allegedly dominant features in likelihood of confusion analysis.

Even if the words were dominant, there is error in considering "INCA" to be dominant over "GIRL". The Examining Attorney errs both in considering a dominant feature to be necessarily present as well as overstating its importance at the expense of other factors. The Examining Attorney cites *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985), for the proposition that "one feature of a mark may be recognized as more significant in creating a commercial impression." While this is correct, this does not justify the Examining Attorney's logical leap that "[g]reater weight is given to *that* dominant feature." (emphasis added.) By assuming the presence of a dominant feature without justification and by giving

weight to the dominant feature without explanation, the Examining Attorney has gone beyond the law, converting “*may be recognized*” into “*shall be recognized*” and dissecting the marks. *National Data* does *not* sanction piecemeal review of marks. On the contrary, “likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *Id.* at 1058.

While more or less weight may be given to different features of a mark, the reliance on a dominant feature was “set forth not as a matter of law, but of logic.” *Id.* at 1060. Likelihood of confusion must “reflect the reality of the market place.” *Id.* The Examining Attorney presented no such logic, ignoring actual marketplace evidence such as Ms. Rhoades' declaration.

In summary, the Examining Attorney presents no arguments or evidence that one portion of the marks is dominant, failed to consider other relevant factors, and generally placed too much emphasis on the common term 'INCA.'

C. There is no dominant word portion of the marks.

Even assuming the assuming the words INCA GIRL dominate the '016 registration and assuming that INCA is a dominant feature in INCA MAMA and further assuming that the words INCA GIRL are properly dissected from the '016 registration, there would be no confusion between the marks.

While the Examining Attorney summarily states that INCA was “the dominant portion,” of both marks this argument is predicated on three unstated and incorrect assumptions: (1) that there must be a dominant portion; (2) that both marks have a dominant portion; and (3) that the dominant portion of both is INCA. The only evidence of record clearly overturns these

assumptions.

The Examining Attorney never alleges that INCA is *likely* to be perceived by customers as a dominant feature or presents any evidence to show that consumers *actually* see INCA as a dominant feature of either mark. While the Examining Attorney does not explicitly say so, repeated use of the definite rather than indefinite article suggests that existence of such a dominant feature is mandatory, contrary to case law. Marks may have a dominant feature. However, such a feature is not mandated by trademark law. “[A] particular feature of a mark *may* be more obvious or dominant.” *Kangol, Ltd. V KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163, 23 USPQ2d 1945 (Fed. Cir. 1992) (emphasis added). The Examining Attorney assumes without presenting any evidence or argument in support that INCA GIRL and INCA MAMA contain a dominant feature.

Even assuming there is a dominant feature in INCA MAMA and INCA GIRL, and assuming the word portion of INCA GIRL dominates the design, the weakness of the INCA weighs against likelihood of confusion. “It has frequently been held that trademarks, comprising two words or a compound word, are not confusingly similar even though they have in common one word or part which is descriptive or suggestive of the nature of the goods to which the marks are applied.” *Smith v. Tobacco By-Products and Chemical Corp.*, 243 F.2d 188, 189, 113 USPQ 339 (CCPA 1957).

Inca standing alone is relatively weak because it suggests the association of the goods and services with the past and present culture of Incan people. Materials supplied with the Request for Reconsideration detail the history of the Incan Empire. Dominant around five hundred years ago, the Incan Empire occupied the highlands along western South American, primarily in

modern day Peru. The materials also indicate that Incan culture exists today.

The Incan culture is known for a number of advanced skills, including use of wool textiles. As a result, the term INCA is often used in association with clothing of Incan style, alpaca wool construction, Incan weaving techniques, or Incan cultural icons or designs. Specific references in the evidence supplied with the Request for Reconsideration detail the use of the term Inca to identify rugs, blankets, yarn, sweaters, shawls, ponchos, hats, gloves, shirts, swimwear, and traditional dress as well as alpacas themselves. *Passim*. The Examining Attorney characterizes this argument as “clothing made of Alpaca wool ... found in the Incan Civilization.” However, Appellant’s argument is not a bald assertion based on historical inference. Notably, the evidence submitted shows *actual use in commerce* in the United States of the term INCA for a wide variety of clothing. Usage of INCA in connection with a variety of brands and styles of clothing shows a weakness of this common term as an identifier of a particular source.

In addition, INCA may refer to the region formerly occupied by the Incan Empire. The evidence included with the Request for Reconsideration shows examples of the term INCA applied to regional soft drinks and jewelry. The Examining Attorney failed to address this evidence in denying the Request for Reconsideration. Association with non-clothing items further weakens the source-identifying value of the term INCA.

Because of the relative weakness of the shared term INCA is unlikely to be the dominant feature in either mark. Consequently, the overall likelihood of confusion based solely on such a weak term is slim.

D. The Examining Attorney blurs distinctions relevant to consumers between MAMA and GIRL in considering them to both merely signify “female.”

The Examining Attorney, in analyzing the dictionary definitions for MAMA and GIRL, concludes that they are both “a term for a female.” While the Examining Attorney admits that these terms “may be used to refer to grown women and younger females,” the decision to prefer the generic “female” meaning is unsupported by evidence or analysis. In addition, this ignores the commercial context in which both marks are used. Both INCA MAMA and INCA GIRL are applied to women's clothing, so the characterization merely as “female” is too coarse.

The descriptive effect of a term must be considered in context. For example, “[n]o one is likely to be confused in buying an ‘of the Sea’ [seafood] product.” *Franco-Italian Packing Corp. v. Van Camp Sea Food Co.*, 142 F.2d 274, 276, 61 USPQ 369 (CCPA 1944). Similarly, considering MAMA and GIRL as merely as “female” vitiates the effect of these terms as applied to women's clothing.

MAMA and GIRL are not mere synonyms. More specific connotations including age and social role signal and differentiate women's clothing brands and go beyond a superficial and generic femininity. MAMA suggests pregnancy, maturity, and family, while GIRL suggests youth and flirtiness. Commercial buyer Dori Rhoades indicated as much in her Declaration included with the Request for Reconsideration. With ten years of experience in the clothing market, Ms. Rhoades has a substantial background in women's clothing and maternity clothing in particular. Ms. Rhoades notes that the mark INCA GIRL “speaks to young, fashion-conscious girls” which conveys “youthful sexiness.” Declaration of Dori Rhoades at 4. The mark INCA MAMA, “conveys a more wholesome nature.” *Id.* These marks display “opposite connotations.” *Id.* Ms. Rhoades’ statement is one based in experience of actual commercial context. In contrast,

the Examining Attorney merely expresses an unsubstantiated opinion that the more generic “feminine” aspect is more important.

While the Examining Attorney is correct that MAMA and GIRL *may* refer to women, it is quite a leap to infer that this means consumers will think these terms are *the same* when buying women’s clothing. Considering them merely as synonyms vitiates their meaning to actual consumers and ignores the evidence of record. Purchasers of women's clothing do not need to be told they are women. Viewed in proper context and in light of the evidence, a narrower meaning connoting age and social role is the actuality of consumer perception.

E. Differences in marketplace realities weigh against likelihood of confusion.

The Examining Attorney failed to consider any market factors, omitting analysis and failing to consider evidence submitted relating to market related factors. While every *DuPont* factor need not be analyzed, important factors cannot be ignored. The Examining Attorney noted the importance of “marketing channels” and “the identity of the prospective purchasers,” yet failed to even to consider marketplace factors. Undisputed evidence demonstrates the additional care of consumers and the different channels of trade.

1. The highly discerning nature of expectant mothers weighs against confusion.

The Examining Attorney failed to consider “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

Pregnancy is an amazing and unique time in a woman’s life. Unsurprisingly, expectant mothers are “calculating and discerning in making their purchases.” Decl. of Dori Rhoades at 3.

The unique experience of pregnancy presents issues not faced in normal clothes shopping. Many expectant mothers have a heightened body consciousness and “look for clothing that will not over exaggerate the pregnant curves.” Id. at 2. In addition, purchasers are “more sensitive to fabrics and yarns in apparel, in consideration of skin stretching and its more itchy nature during pregnancy.” Id. at 2. Maternity clothing requires special consideration in design and construction; these considerations are “not addressed by general contemporary clothing manufacturers.” Id. at 3. In addition, maternity clothes are difficult to fit. Although “two women might otherwise fit into the same clothing,” during pregnancy, the “belly line ... may vary from woman to woman.” Id. The novelty of shopping for maternity clothes, as well as unique body issues posed by pregnancy, demand additional consideration and result in discerning purchasers.

To handle these additional requirements, maternity clothing sales staff often have special training and experience. “The retail salespeople for maternity clothing are generally persons with some skill at assisting potential purchasers through these considerations and have training and experience different from the contemporary clothing salespersons.” Declaration of Dori Rhoades at 3.

The purchasing situation described above amplifies the ability of purchasers to exercise a higher level of discretion in purchases and differentiate between goods. This heightened care weighs against a likelihood of confusion. Notably, the Examining Attorney has produced no evidence of record to contradict this conclusion.

2. Differences in channels of trade weigh against likelihood of confusion.

The Examining Attorney failed to address “similarity or dissimilarity of established,

likely-to-continue trade channels.” *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361.

While every *DuPont* factor need not be analyzed, important factors cannot be ignored. Proper consideration of evidence shows that contemporary and maternity clothes are marketed and sold in different channels of trade. This weighs against likelihood of confusion.

Maternity clothes such as those market with INCA MAMA are generally sold in different locations from “contemporary” clothes such as those marked by INCA GIRL. At the wholesale level, maternity clothing is generally presented at “specialty tradeshowes and showrooms.”

Declaration of Dori Rhoades at 2. Conversely, “general clothing, known in the trade as 'contemporary' clothing, is typically shown to customers at seasonal tradeshowes and at showrooms.” At the retail level, “maternity clothing is typically sold in specialty boutiques.” *Id.*

The Examining Attorney’s statement that “many entities provide both maternity and non-maternity clothing is correct.” Even though some companies sell both maternity and contemporary clothing, this does not mean that the sales channels are the same. For example, The Gap Company sells both maternity and contemporary clothes, though maternity clothes are available only at Baby Gap stores while contemporary The Gap stores do not carry maternity clothes. *Id.* Although some online stores sell both maternity and contemporary clothes these are “offered via distinct sections of the website.” *Id.* The Examiner Attorney’s own evidence supports this point. For example, attachment 38 to the Denial of Request for Reconsideration shows that this product was taken from the “maternity shop.” Similarly, attachment 44 shows separate links for “APPAREL” and “MATERNITY.” Further, attachment 61 shows separate tabs for “Women” and a separate tab for “GapMaternity.” Evidence submitted both by Appellant and Respondent show that maternity and contemporary clothing are separated and clearly marked.

The Examining Attorney's assertion that likelihood of confusion "is determined on the basis of the goods or services as they are identified in the application and the registration" is simply wrong. Even the case cited in support, *Canadian Imperial Bank* states that goods named are simply one element:

[T]he issue must be resolved on the basis of not only a comparison of the involved marks, but also on consideration of the goods named in the application and in opposer's registration and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution.

Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat. Ass'n, 811 F.2d 1490, 1492, 1 USPQ2d 1813 (Fed. Cir.1987). This is also inconsistent with factor two of the *DuPont* test, "The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark *is in use*." *DuPont*, 476 F.2d at 1361 (emphasis added). The third *DuPont* factor explicitly requires analysis of "established, likely-to-continue trade channels." *Id.* Looking to these trade channels shows that maternity and contemporary clothing are treated separately. Particularly, the INCA GIRL line "is not sold through stores that carry maternity clothing." *Id.* at 3.

Because the mark INCA MAMA is applied to maternity clothing, the marketing channels are quite different from the goods and services market with INCA GIRL. Ms. Rhoades noted that "[c]ontemporary and maternity clothing are also advertised in different ways." Declaration of Dori Rhoades at 2. Maternity clothing is advertised in specialty magazines such as *Pregnancy*, *Fit Pregnancy*, *Pregnancy and Newborn*, *American Baby*, and *Plum*. *Id.*

Further, maternity and contemporary clothing are likely not purchased by the same consumers. The INCA GIRL line of clothing is "marketed to girls and younger women who

generally are some time away from planned pregnancy.” Declaration of Dori Rhoades at 3. Beyond the fact that pregnant women cannot wear contemporary clothes due to their belly line, “purchasers of maternity clothing tend to look for clothing that will not over exaggerate the pregnant curves.” Declaration of Dori Rhoades at 2. In contrast, the INCA GIRL design features “scant attire.” *Id.* at 4.

Evidence showing that maternity and contemporary clothes are sold in different channels of trade weighs against likelihood of confusion.

In summary, the Examining Attorney has failed to properly address two relevant *DuPont* factors. Specifically, the Examining Attorney failed to consider:

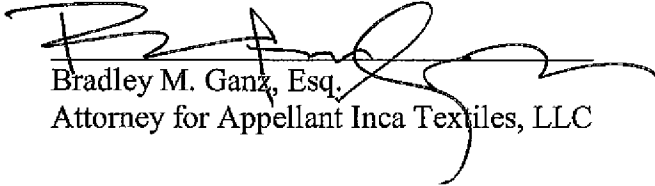
1. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
2. The similarity or dissimilarity of established, likely-to-continue trade channels; and
3. To whom, and the conditions under which, sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.

Discarding the Examining Attorney’s personal opinion in favor of uncontested evidence of record shows that these factors support the Appellant.

CONCLUSION

In light of the arguments herein and of prior record, Appellant respectfully requests that the Examining Attorney's refusal be reversed.

Respectfully submitted,



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